

REMARKS

In accordance with the foregoing, claims 18, 19 and 26 have been amended. Claim 15 has been cancelled. Claims 1-9, 11-14, 16, 18-20 and 22-26 are pending.

No new matter is believed to have been added.

I. REJECTION OF CLAIMS 1-8, 18, 19 AND 26 UNDER 35 USC § 102(b) AS BEING ANTICIPATED BY LICHTENSTEIN (US PAT. NO. 5,428, 417, "LICHTENSTEIN").

Lichtenstein discloses an overlay projector, which enables a lecturer to overlay icons, highlighting bars and alpha-numeric labels on an underlying presentation. (See Lichtenstein Abstract). Lichtenstein discloses that all of the selectable icons and display control buttons execute commands. For example, when a user of the system in Lichtenstein selects the arrow 114, the arrow 132c is displayed at a predetermined location of the display panel 19 and the arrow 132d is displayed on the viewing screen 28. (See Lichtenstein FIG. 1). The display panel 19 of Lichtenstein displays a menu of selectable icons and display control buttons. (See Lichtenstein FIGs. 1, 9A-9B and col. 10, lines 56-59).

In contrast, claim 1 recites, "an operation mode selecting unit selecting any one of two or more operation modes with respect to the touch operation, wherein a first mode is settable to provide a first function corresponding to the touch operation if the touch operation is detected on said operation screen unit, and a **second mode is settable to provide a second function of displaying a marker for indicating a detection of the touch in a touch position** if the touch operation is detected on said operation screen unit, **and the first function corresponding to the touch operation is not executed.**" (Emphasis added).

The Action alleges that the menu 22 of displayed icons 19a and control buttons 19b of Lichtenstein anticipate the "operation mode selecting unit" recited in each of the independent claims 1, 5, 18, 19 and 26. (See Action pages 2-3). However, Lichtenstein does not disclose the "operation mode selecting unit" having two separate operation modes, one of which executes a command, and another operation mode that displays a marker at the touch position without executing the corresponding command, as recited in claims 1, 5, 18, 19 and 26.

The system of Lichtenstein executes a command corresponding to the touch, (i.e., the arrow 114 and display at a predetermined location) rather than not executing the corresponding touch operation as recited in claim 1. Furthermore, the display of the marker (i.e., the arrow

132c) occurs at a predetermined location in the display are 19c rather than at the touch position. (See Lichtenstein col. 10, lines 52-59 and col. 13, lines 5-10).

Claim 5 recites, **"a control unit controlling execution and display modes on said operation screen unit, wherein if the execution mode is selected a command corresponding to the touch operation if the touch operation is detected on said operation screen unit is executed, and if the display mode is selected a marker displaying a detection of the touch in a corresponding touch position if the touch operation is detected on said operation screen unit, and the command corresponding to the touch operation is not executed."** (Emphasis added). In contrast, as discussed above, Lichtenstein discloses only executing commands at whatever location is touched.

Claims 18 and 19, as amended, recite limitations similar to those highlighted in claim 1 and the arguments discussed above for allowance of claim 1 are applicable to claims 18 and 19 as well.

Claim 26, as amended, recites **"a display control unit controlling display of the information on the operation screen unit, wherein a display mode of the display control unit is settable to display a marker on the operation screen unit corresponding to a touch position of the detected touch operation, and executing a command corresponding to the information at the touch position if the user touches the operation screen unit within a region of the touch position and discarding the command corresponding to the information at the touch position if the user touches the operation screen unit at a new touch position outside the region of the touch position while displaying the marker at the new touch position."** (Emphasis added). In contrast, as discussed above, Lichtenstein does not discuss discarding the commands at a touch position; rather, Lichtenstein always executes a command corresponding to the touch position.

Claims 2-4 and 6-8 depend from claims 1 and 5, respectively, and are believed allowable for at least their dependence upon an allowable independent claim.

In view of the above, it is respectfully submitted that the rejection of claims 1-8, 18, 19 and 26 are overcome.

II. REJECTION OF CLAIMS 9, 11-13, 15, 16, 20 AND 22-24 UNDER 35 USC § 103 AS BEING UNPATENTABLE OVER LICHTENSTEIN (US PAT. NO. 5,428, 417, "LICHTENSTEIN") IN VIEW OF PLATZKER ET AL. (US PAT. NO. 5,528,263, "PLATZKER").

In order to establish a prima facie obviousness rejection, the Action needs to provide in the relevant prior art both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. All the elements and the motivation to combine the elements need to be shown to have existed in the prior art. MPEP 2143.01.

Platzker discloses an interactive projected image video display that detects a user interaction with an image projected on a screen. (See Platzker Abstract). Platzker discloses that a predetermined time 110 is used to determine if a pop up menu 68 should be displayed as part of the projected image 24. (See Platzker col. 9, lines 5-10). After a set period of time with no selection by the user from the pop up menu 68 the menu disappears. (See Platzker col. 9, lines 17-24).

As discussed in the arguments for allowance with respect to item I above, Lichtenstein does not teach or suggest all the claimed limitations.

For example, claim 9 recites, "[a]n information processing system, to which a display unit displaying information and a pointing device for indicating coordinates on said display unit are connectable, said system comprising: a detection unit detecting an operator's input operation of indicating the coordinates by use of said pointing device; and a display control unit **displaying a marker for showing the respective coordinates on said display unit indicated by the input operation**, an operation mode selecting unit selecting any one of a first operation mode for providing a first function of executing a normal command corresponding to the operator's input operation using said pointing device, and **a second operation mode for displaying the marker for a predetermined time and not executing the normal command corresponding to the operator's input operation** using the pointing device." Lichtenstein does not discuss providing a separate second operation mode, at the same touch position instead of the first function for a predetermined time.

With respect to Platzker, the Action is relying on an isolated step in a flowchart for the teaching of a "predetermined time." (See Action at page 5). However, Platzker works in a very different manner than Lichtenstein, namely, in Platzker, a user may select a frame of a projected

image 24 by overlaying a recognized feature (e.g. a hand or predetermined pointing object) over the frame portion of the projected image. (See Platzker col. 6, lines 9-27). The predetermined time 110 is used to determine if a pop up menu 68 should be displayed as part of the projected image 24, which the user can then use to select a command from the pop up menu by overlaying a recognized feature over the command. (See Platzker col. 9, lines 5-10). After a set period of time with no selection by the user from the pop up menu 68, the menu disappears. (See Platzker col. 9, lines 17-24). However, the motivation for having a large command pop up menu, which obscures the image, disappear does not necessarily apply to the identifying arrows or text of Lichtenstein.

No motivation can be found in either reference to combine the apparatus of Lichtenstein with the system of Platzker. It appears that the present invention is being used as the motivation to combine Lichtenstein and Platzker, which is engaging in improper hindsight.

Claim 16 recites, "[a] method of controlling an information processing system, to which a display device is connected, having an operation screen unit capable of displaying information and detecting a touch operation on its surface, said method comprising, when no information is displayed on said operation screen unit, functions of: detecting the touch operation on said operation screen unit; displaying a marker in a coordinate position on said display device, **which corresponds to a position of the detected touch** on said operation screen unit; **detecting the position of a mode selection switch**; and if the mode selection switch is in a first position, executing a function indicated by the marker on said display device, and **if the mode selection switch is in a second position continuing to display the marker in the coordinate position on said display device for a predetermined time, and not executing the function indicated by the marker** on said display." In contrast, as discussed above, Lichtenstein, either alone or in any proper combination with Platzker, does not discuss not executing the commands at a touch position; rather, Lichtenstein always executes a command corresponding to the touch position.

Claim 20 recites, "detecting an operator's input operation of indicating the coordinates on a display unit by use of a pointing device being connected to the computer; **displaying a marker for showing the respective coordinates on said display unit** indicated by the input operation; **selecting any one of a first operation mode for providing a first function of executing a normal process corresponding to the operator's input operation using said pointing device, and a second operation mode for displaying the marker in the coordinate position on said display unit for a predetermined time, and not executing the function indicated by the marker** on said display." In contrast, as discussed above, Lichtenstein, either alone or in any

proper combination with Platzker, does not discuss not executing the commands at a touch position; rather, Lichtenstein always executes a command corresponding to the touch position.

Claims 11-13 and 22-24 depend from claims 9 and 20, respectively, and are believed allowable for at least their dependence upon an allowable independent claim.

The cited references do not suggest the motivation to combine or teach all the elements of the claimed invention and thus, a prima facie case of obviousness has not been demonstrated.

In view of the above, it is respectfully submitted that the rejection of claims 9, 11-13, 16, 20 and 22-24 is overcome.

III. REJECTION OF CLAIMS 14 AND 25 UNDER 35 USC § 103 AS BEING UNPATENTABLE OVER LICHENSTEIN (US PAT. NO. 5,428, 417, "LICHENSTEIN") IN VIEW OF PLATZKER ET AL. (US PAT. NO. 5,528,263, "PLATZKER"), AND FURTHER IN VIEW OF MARTIN (US PAT. NO. 5,448, 263, "MARTIN").

Applicants respectfully traverse this rejection, since a prima facie case of obviousness has not been set forth.

Claims 14 and 25 depend from claims 9 and 20, respectively. Martin does not cure the defects of Lichtenstein and Platzker, which do not teach or suggest every limitation of independent claims 9 and 20.

Thus, because Martin does not cure the defects of either Lichtenstein or Platzker a prima facie case of obviousness is not properly set forth.

In view of the above, it is respectfully submitted that the rejection of claims 14 and 25 is overcome.

IV. CONCLUSION.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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